

The applicants respectfully traverse the Examiner's rejection under 35 U.S.C. 251 of claims 42-46. The Examiner, citing In re Clement, states that the basis of the "recapture" rejection of the above claims is found in the applicants' response (Attached as Exhibit 1) to the Office action of May 22, 1995 (Attached as Exhibit 2) in patent application SN 08/167,002, which is the parent of SN 08/709,112 and now USP 5,761,621. In that response, the Examiner correctly notes that the following amendments to claim 1 of the '112 application (which is drawn to a radio frequency management system for reallocation of radio spectrum) included the following items:

**Item 1.** "a plurality of wireless communication networks using differing radio frequency modulation protocols and differing radio frequencies"

**Item 2.** "a first wireless communication network operating using a first radio frequency spectrum allocated to said first wireless communication network and using a first modulation protocol"

**Item 3.** "a second wireless communication network operating using a second radio frequency spectrum allocated to said second wireless communication network and different from said first radio frequency spectrum and using a second modulation protocol"

In the current Office action, the Examiner asserts that submission of the above amendments constituted surrender of broader subject matter from the originally filed claim 1 where the above features do not appear. The Examiner explains the rejection further by stating, at page 6, that:

"it is still considered that reissue claims 42-46 are directed more toward claims 1 and 13 in that they both commonly deal with radio frequency management system which reallocates radio spectrum

among a plurality of wireless communication networks having different frequencies and protocols through use of control signal generation.” (emphasis added)

The applicants traverse this finding of impermissible “recapture” under In re Clement (Exhibit 6) for several reasons.

Initially, the applicants would point out that In re Clement teaches that recapture of surrendered material occurs when the patentees make amendments to the patented claims which broaden the scope of the patented claims wherein the subject matter of the broadening is directly related to subject matter which was surrendered (by amendment) to secure allowance during the Patent Office proceedings which resulted in issuance of the original patent. In Clement the patentees presented, during original examination, amendments as shown below in underline, which continually narrowed the one and only independent method claim, drawn to a method of processing pulp to remove “stickies” and inks, in order to avoid the prior art applied by the Examiner:

A method of treating a mixture of printed and contaminated waste paper in order to produce a pulp for use in the manufacture of paper and paperboards, said waste paper containing non-ink contaminants including stickies, which method comprises:

(a) forming a first aqueous fibrous suspension of said waste paper at room temperature by applying specific mechanical energy lower than 50 KW.H/Ton to form a pumpable slurry and to release substantially all of the non-ink contaminants including the stickies, from the surface of the paper and without dispersing such non-ink contaminants as finely divided particles throughout the fibrous suspension;

(b) removing substantially all of the non-ink contaminants including the stickies, which have been released without dispersal as finely divided particles from the first fibrous suspension by screening and cleaning at room temperature to form a second aqueous fibrous suspension substantially free of the non-ink contaminants including the stickies;

(c) after the step of removing the non-ink contaminants softening the ink vehicles and weakening their binding with the surface of the fibers by submitting the second fibrous suspension at a consistency of more than 15% to the simultaneous actions of (A) a high temperature between 85.degree. and 130.degree. C., (B) high shear forces substantially corresponding to a specific mechanical energy of more than 50 KW.H/Ton applied at the said consistency of more than 15% and (C) at least one deinking agent under strong alkaline conditions having a pH of at least 9; and

(d) detaching the ink particles from the surface of the fibers and dispersing them into the second fibrous suspension by submitting the second fibrous suspension to the simultaneous actions of (A) high temperature between 85.degree. and 130.degree. C., (B) high shear forces substantially corresponding to a specific mechanical energy of more than 50 KW.H/Ton applied at the said consistency of more than 15% and (C) at least one chemical dispersing agent, under strong alkaline conditions having a pH of at least 9 whereby higher specific energy inputs and higher temperatures are used to detach the ink particles from the fibers of the second fibrous suspension after removal of the non-ink contaminants than are used on the first fibrous suspension before removal of the non-ink contaminants;

(e) limiting the total duration of the ink softening and detaching steps (c) and (d) to a range between 2 and 10 minutes and

(f) removing the detached ink particles from the second fibrous suspension to provide a brightness of at least 59 ISO the final pulp.

The patentee, in the subsequently filed reissue application tried to remove those limitations, shown in double underline above, as being unduly restrictive. The Clement decision states that such removal of limitations added to secure allowance of a claim, rejected on prior art, is impermissible. As originally issued, the Clement patent included only a single independent claim which had been the subject of repeated narrowing amendments during the prosecution proceedings prior to issuance of the Clement patent. No independent claim(s) to other embodiments, such as treatment systems, compositions, or products was submitted during the original examination or in the reissue proceeding. Based on this fact pattern (other litigated

reissue cases to follow), the Clement court was able to identify claimed subject matter that was “surrendered” in order to secure allowance of the original patent.

In contrast to Clement, the prosecution of the subject ‘621 patent provides no bright line of demarcation regarding subject matter “surrendered.” In particular, as initially filed, the application which resulted in issuance of the ‘621 patent included the precursors of independent claims 1 and 13 directed respectively to a system for radio frequency management for reallocation of the radio spectrum (claim 1) and a method for reallocation of radio frequency spectrum (claim 13). Following a prior art rejection, claims 1 and 13 were amended and simultaneously a new independent claim (claim 23) was submitted by a response received in the U.S. Patent and Trademark Office on May 22, 1995 (Exhibit 1). As shown in the attached Chart A (see attached Exhibit 3 in BLUE), only claim 1, drawn to the radio frequency management aspect of the invention, was limited by the addition of limitations identified above as Items 1, 2 and 3. Claim 13 was further limited only by the language of item 1.<sup>1</sup> Significantly, however, in the very same response, applicants submitted new claim 23 (also show in the attached Chart A) directed to “A radio frequency management system for providing information useful in selecting among a plurality of wireless communication networks having different and variable operating characteristics” (emphasis added – see Chart A in RED) including “processing means” connected with network load monitoring means “...for receiving a signal indicative of said current network load and for generating a signal representing current operational characteristics of each of the wireless communications networks in response thereto.” The specification of the ‘621 patent provides a number of examples of the type of “operational characteristics” including, for example, “available bandwidth” (see column 16, lines 37-38) which may be transmitted to the

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<sup>1</sup> Admittedly claim 13 already included limitations similar to items 2 and 3.

individual portable radio devices of the system. In particular, the specification states that information regarding the “operating characteristics” of networks that are used to allow network selection (see column 19, lines 33-35), may be broadcast directly to the portable units (see column 19, lines 26-35 and column 19, lines 45-46). Accordingly claim 23, submitted at the time of the alleged “surrender” of patentable subject matter, is directed to a radio frequency management system that facilitates selection from among a plurality of networks having different and variable operating characteristics where the operating characteristics can include “bandwidth” i.e. assigned frequency. Thus, claim 23 (that was never rejected on prior art) broadly covers systems that facilitate selection among plural networks that differ from one another in a variety of ways described in language that is broader than the language describing networks contained in claims 1 and 13 as originally filed and as amended. Please note that the applicants response (Exhibit 1), at page 20, lines 4-14, discusses how the broad claim 23 embodiment is related to the “frequency management” systems of claims 1 and 13. As a consequence, the radio frequency management system of claim 23 submitted at the time of the alleged surrender is actually broader in the very subject matter that was allegedly “surrendered” when claims 1 and 13 were amended.

In a recent CAFC decision dated July 25, 2001, Pannu et al. v. Storz Instruments Inc. (CAFC July 2001) (Exhibit 5), the court reaffirmed that application of the recapture rule of Clement was a three-step process. The first step is to “determine whether and in what ‘aspect’ the reissue claims are broader than the patent claims.” The second step is to “determine whether the broader aspects of the reissued claim related to surrendered subject matter.” Finally, the court must determine whether “the reissued claims were materially narrowed in other respects to avoid the recapture rule.” Citing Hester, 46 USPQ2d at 1,649-50 (Exhibit 7). Applicants

respectfully submit that the outstanding rejection of applicants' claims 42-46 is unsupportable under this three-step process.

Initially, reference is made to Chart B (Exhibit 4) including claims 42 through 46 wherein the language describing the type of networks is highlighted in RED. Admittedly, the language highlighted in RED is somewhat broader than the amendatory language describing the network differences contained in claims 1 and 13 but in every instance the language is narrower than is the language contained in claim 23. Thus, claims 42-46 are not broader than the claims issued in the '621 patent in the area identified by the Examiner in his rejection based on the recapture rule.

Second, the prosecution history of the '621 patent in no way supports the Examiner's holding that applicants clearly surrendered subject matter by amending claims 1 and 13 because, in the same response, a new claim (claim 23), drawn to a broader embodiment of the invention, was submitted which includes broader limitations directed to a "plurality of wireless communication networks having different and variable operating characteristics" in a radio frequency management system. As noted above these "operating characteristics" can include a variety of network characteristics including "bandwidth" (that is assigned frequency) and thus claim 23 is actually broader than original claims 1 and 13 in the very subject matter that the Examiner alleges was "surrendered."

Third, claims 42-46 are each materially narrowed in ways that cause these claims to avoid the recapture rule. Chart B demonstrates that each of claims 42 through 46 are both broader in some respects and narrower in other respects than each of claims 1, 13 and 23 as issued in the subject '621 patent. The differences among claims 1, 13 and 23 demonstrate that the subject invention has a number of different aspects, and claims 42 through 46 are directed to

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still other aspects that were omitted, through error without deceptive intent, during the prosecution and issuance of the '621 patent.

In particular, each of the newly presented claims 42-46 is drawn to a wireless communication system organized to promote user driven competition among a plurality of independent wireless networks by permitting the selection of an available network depending on the network characteristics (claims 42, 43, 45, 46) or user defined criteria (claims 42, 44), which can include the strength of signal, cost of call, network availability, and network security. While each of claims 42-46 share features from both claim 1 and claim 23, none of the claims 42-46 is drawn to the specific combination of features defining a system for "radio frequency management for reallocation of the radio spectrum" as in claim 1 (and dependent claim 2), or a "load monitoring means" as specifically defined in claim 23. Therefore, claims 42-46 are mutually narrowed in ways to avoid the recapture rule. Of particular note, is the fact that in claims 42-45 the plural wireless network are said to be "commercially independent" and in claim 46 the networks are limited to "independent" networks, and also narrower in the very subject matter wherein the Examiner is alleging that claims 42-46 are impermissibly broadened in an attempt to recapture subject matter relinquished to secure allowance.

Moreover, Court-decisions and the PTO rules specially recognize that claims directed to additional embodiments of an invention may be submitted in a Reissue application. For example, the presentation, in one or multiple reissue applications, of additional embodiments of a disclosed and patented invention (that is, the filing of continuing (reissue) applications for parts of the initial patent which **are not for separate and distinct parts of the thing patented**) is specifically permitted by In re Graff, 111 F.3d 874, 42 USPQ 2nd 1471, see MPEP 1451-DIVISION REISSUE APPLICATIONS. Further, In re Clement provides no precedential

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guidance for extending the recapture of surrendered subject matter in one embodiment (system for operation) of an invention to other embodiments of the invention, i.e., method of making, compositions, or products. For the Examiner's convenience along with a copy of the Pannu et al, Clement, and Hester decisions also provided with each is a copy of the original patents upon which reissue was sought in each of the cases as well the identification of the claims at issue. Note, that in both Clement (USP 4,780,179) and Hester (USP 4,582,047) only a single inventive embodiment (claim) was presented in the form of a single independent claim; while in Pannu et al (USP 4,435,855) two independent claims were presented, a device (claim 1) and a method (claim 10), but only the device embodiment (claim) was the subject of reissue amendments determined to constitute impermissible broadening. In each case, the independent embodiment sought for reissue was the same embodiment presented in each of the original patents, unlike the presently submitted claims 42-46.

It is further noted, that the fact that the instant claims 42-46 share a common feature, i.e., a "control signal generator" with patent claims 1 and 13 is not relevant to the required three-step process of Pannu et al above since claim 23 states that each of the plurality of portable radio devices selects one of the said plurality of wireless communications networks in response to operational characteristics transmitted to the portable radio device. Such a function is broad enough to include a step of generating a control signal for controlling access of each portable radio device. Since claim 23 states that each network has "variable operating characteristics" which could be frequency or protocol characteristics (claims 42-44), frequency characteristics alone (claim 45) or differing communication channels (claim 46), it is incorrect to assert that claims 42-46 are closer to claims 1 and 13 than to claim 23.





In light of the above noted discussion, the applicants assert that the Examiner's finding that the inventions of claims 42-46 **"are directed more toward claims 1 and 13 in that they both commonly deal with a radio frequency management system....through the use of control signal generation"** is not an appropriate criteria for determining impermissible recapture under 35 U.S.C. 251 as set forth by Clement, Hester or Pannu et al, and Examiner's findings do not rely on the three-step test required by Clement, Hester or Pannu et al. For this reason alone the Examiner's rejection of claims 42-46 under 35 U.S.C. 251 should be withdrawn.

In summary, applicants have illustrated above that the subject matter referred to by the Examiner as being "broadened" was not in fact surrendered as required by step (2) of Pannu et al. In the response of May 22, 1995 (Exhibit 1), pending claim 1 was indeed amended, as indicated by the Examiner, but in the very same amendment, new independent claims 23 was added which included none of the limitations that were added to claim 1. The prosecution record of the '621 patent simply does not support the Examiner's conclusion that applicants' are now trying to recapture subject matter that was surrendered. No creative finding that the reissue claims are "closer" to claims 1 and 13 that to claim 23 can cover up the fact that no identifiable subject matter was surrendered. Finally, since claims 42-46 have been materially narrowed in other aspects to avoid recapture (i.e., limited to "independent" or "commercially independent" networks and to a "wireless communication system to promote user driven competition" (claims 42-45) or a "wireless communication system organized to permit maximum utilization of the available radio spectrum" (claim 46), the Examiner's holding of impermissible recapture under 35 U.S.C. 251 for claims 42-46 is improper and should be withdrawn.

With regard to the Examiner's rejection of claim 44 under 35 U.S.C. 103(a) as being unpatentable over Zicker in view Andrews and Barber et al is respectfully traversed. The newly

amended claim 44 now requires, like claim 42, that the “user defined criteria” for selecting a wireless service be stored in memory. As pointed out in the applicants’ earlier response, the Zicker reference, while teaching hardware similar to that claimed, actually teaches and suggests a wireless communication network system which is the exact opposite of that instantly claimed. Specifically, Zicker (column 2, lines 60-68; column 3, lines 1-25) sets forth a wireless communication network system in which **the user is not regarded as qualified to make instantaneous pricing decisions while “roaming”**, and, therefore, the wireless communication network system **takes that network access decision-making process out of the users hands**. Zicker then sends to each subscriber’s cellular phone the necessary data (including available system telephone identifiers, e.g., phone numbers) which are determined at a central provider location. This process is carried out automatically, with no user input, by sending call availability information “automatically” to each cellular phone on the provider’s network (column 16, lines 47-53). The Zicker system does not have the claimed feature of “memory for storing a user defined criteria for selecting a wireless service” since the patentee teaches that a roaming customer **“is not prepared to make, or interested in making, a purchasing decision with response to telecommunication, services every time he or she is roaming. While roaming, a customer is unlikely to know the rates charged by the competing foreign cellular systems. Moreover the rate structures may be too complicated...”** (emphasis added). In the Zicker wireless communication network system, the user has no ability to enter his or her own defined criteria for selecting an available network.

The Andrews reference, which teaches providing cellular phones with the ability to access multiple networks operating at multiple frequencies by having frequency and protocol agile circuitry, does not remedy the deficiency of Zicker noted above. Nor has the Examiner

provided any suggestion or motivation as why one of ordinary skill in the art would modify the provider controlled wireless communication network system of Zicker with a system as in Andrews in which the user controls the selection of an available network according to memory stored user defined criteria as is instantly claimed.

The newly added Barber et al reference has been carefully considered, but does not remedy the deficiencies of Zicker. Barber et al, like Zicker, sets forth a provider controlled cellular network. Specifically, the patentees point out at numerous locations that the preferred list of networks (SID and NAM numbers) are entered into the cellular phone by an "installer technician" (see column 4, lines 55-64; column 4, lines 26-34; column 6, lines 24-33). The user can only select from among the three options for network selection predetermined by the cellular phone manufacturer (column 3, lines 51-60; column 8, lines 27-56), where the preferred networks SIDs and NAM's are provided by the installer technician (and not the user). The three options are 1) the Roam Saver selection (the phone selects the network from any preferred or non-preferred network for any SID detected), 2) the Home Only option (only the Home network carriers are selected), or 3) the SID only option (only a user defined carrier). None of these network selection options is the same as that claimed where the network selection is performed according to "user defined criteria" stored in memory for use by the control signal generator. In fact, the Barber et al reference is completely silent as to any "user defined criteria", such as example strength of signal, cost of the calls, or probability of being dropped, which is stored in memory and used to select a network carrier.

For these reasons, claims 1-41 and 42-46 are in condition for allowance. However, should the Examiner find some issue to remain unresolved, or should any new issues arise, which could be eliminated through discussions with applicant's representative, then the



Examiner is invited to contact the undersigned by telephone in order that the further prosecution of this application can thereby be expedited.

Upon the Examiner finding that claims are in condition for allowance, the applicants request that consideration begin of the Request for Declaration of Interference 37 CFR 1.607 filed on September 8, 1999 concerning copied claims 26-41 from USP 5,805,633.

Respectfully submitted,

Date: \_\_\_\_\_

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ATTACHMENT TO AMENDMENT

**IN THE CLAIMS:**

44. A wireless communication system organized to promote user driven competition among a plurality of commercially independent wireless service providers, comprising

- a. a plurality of independent wireless service networks operated by the wireless service providers to provide wireless services within a common geographic region using differing frequencies and/or differing protocols.
- b. a plurality of portable radio devices, located within the geographic region. that are sufficiently frequency and protocol agile to allow access to more than one of the wireless service networks. each said portable radio device including
  - i. an accessing circuit for providing access to any one of a plurality of the wireless service networks by requesting access and, if available, establishing access in response to an access control signal that adjusts the radio frequency and the protocol of the associated portable radio device as necessary to access the selected wireless service network.
  - ii. memory for storing a user defined criteria for selecting a wireless service. and
  - iii. control signal generator for automatically generating the access control signal in response to an automated selection of the wireless network that best satisfies the stored criteria for wireless service and for causing said accessing circuit to access the wireless service network identified by the access control signal generated.

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